

### REMARKS

Claims 1-24 were presented and rejected. By this Amendment, new claims 25-28 are added, and the specification is amended to overcome various objections raised by the office action. Reconsideration and allowance of pending claims 1-28 in view of the above amendments and following remarks are respectfully requested.

#### Specification Objections

The abstract was objected to because it contains more than 150 words, includes the legal phraseology “said layers,” includes an alleged sentence fragment, and has a misspelled word. 2/19/09 Office Action, ¶ 2. Applicants have amended the abstract to address each of these issues, and therefore respectfully request the withdrawal of this objection.

The specification was objected to on the ground that page 14 includes an incomplete statement “for example the HORIBA LA-920 manufactured by ...” 2/19/09 Office Action, ¶ 3. Applicants have amended this paragraph by deleting the phrase “manufactured by .....” so as to make a complete statement. Applicants therefore respectfully request the withdrawal of this objection.

The specification was objected to on the ground that “reference to Figure 4F on page 22 in the last sentence of the second paragraph, ‘In Figure 4F, if amended layer 120...’ should be to Figure 5F.” 2/19/09 Office Action, ¶ 3. Applicants have made the requested amendment to this paragraph to correct this typographical error, and therefore respectfully request the withdrawal of this objection.

The specification was objected to on the ground that “reference is made to uniform layer 16 in Figures 7G-K (pg 23, 1<sup>st</sup> paragraph), however, no such layer is indicated in the figures.” 2/19/09 Office Action, ¶ 3. Applicants have amended this paragraph to correct this typographical mistake by changing “uniform layer 16” to “uniform layer 114,” which is illustrated and referenced in FIG. 7K. Applicants therefore respectfully request the withdrawal of this objection.

#### Hill

Claims 1, 2, 9, 10, 11, 16, 17, and 21-24 were rejected under 35 U.S.C. § 103(a) as obvious over Hill (WO 00/46043). 2/19/09 Office Action, ¶ 5. Applicants respectfully traverse this rejection for the following reasons.

Claim 1

Claim 1 recites, among other things, “subjecting said sheet of glass and said plurality of layers to a heat treatment process wherein said glass frit ... binds another of said layers within said print pattern.” The office action asserts that Hill’s “downcoat 38” is the recited “another of said layers.” See 2/19/09 Office Action, p. 4 (asserting that the layer/downcoat 38 is the recited another of said layers because “parts of layer 38, burned off during the heat treatment, exist outside of the print pattern”). Based on the office action’s rationale, Applicants understand that reference number “38” was a typographical error, and that the office action meant to refer to Hill’s “covercoat 36,” not undercoat 38.<sup>1</sup> As recognized by the office action, the heat treatment process in Hill causes the layer 36/38 to vaporize. Consequently, the heat treatment in Hill cannot cause any glass frit to “bind[]” such a vaporized layer within said print pattern, as recited in claim 1. Thus, because the layers 36/38 are vaporized, rather than bound by the glass frit within the print pattern, neither of Hill’s layers 36/38 can be the recited “another of said layers.” Hill does not disclose “subjecting said sheet of glass and said plurality of layers to a heat treatment process wherein said glass frit ... binds another of said layers within said print pattern,” as recited in claim 1. Nor does Hill render such a combination of recitations obvious because Hill’s layers 36/38 are specifically designed to be vaporized, rather than to be bound by the glass frit within the print pattern.

Similarly, claim 1 recites a “method of making a glass panel that is partially printed with a plurality of layers,” which by definition includes the recited “another of said layers.” Hill’s downcoat 38 and covercoat 36 cannot be the recited “another of said layers,” as proposed by the office action, because they are vaporized during Hill’s process, and therefore do not form a part of the “glass panel that is partially printed with a plurality of layers,” which is the recited result of the claimed method of claim 1.

For at least these reasons, Applicants respectfully request the withdrawal of this obviousness rejection of claim 1, as well as its dependent claims, which are patentable over Hill at least because they depend from patentable claim 1.

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<sup>1</sup> The Examiner erroneously asserts that “parts of layer 38, burned off during the heat treatment, exist outside of the print pattern.” 2/19/09 Office Action, p. 4. As shown in FIGS. 5A-5D of Hill, that is not true, as the covercoat 36, rather than the undercoat 38, is disposed outside of Hill’s print pattern and burned off. For the purpose of this response, Applicants presume that the Examiner intended to refer to the covercoat 36. Applicants

Dependent Claim 9

Applicants also specifically traverse this rejection as applied to dependent claim 9, which recites, among other things, that “said another of said layers comprises pigment.” The office action alleges that Hill’s covercoat 36 is the recited “said another of said layers.” However, that covercoat 36 is merely a lacquer that does not “comprise pigment,” as recited in claim 9. *See* Hill, p. 40, line 17.

Moreover, it would not have been obvious to include pigment in the covercoat 36 (i.e., the alleged “said another of said layers”) because such pigment would remain in the “unimaged areas 28” (shown in Hill, FIG. 5F below) outside of the print pattern after vaporization of the remainder of the covercoat 36 (shown sequentially between FIGS. 5E and 5F below). Hill, p. 40, lines 11-22.

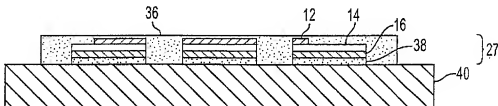


FIG. 5E

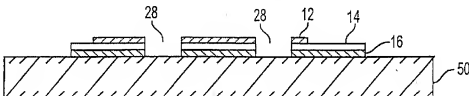


FIG. 5F

Hill

Such pigment would obstruct the view through the unimaged areas 28, thereby defeating Hill’s goal of providing vision through such unimaged areas 28. *See* Hill, p. 1, line 5, to p. 4, line 28. Indeed, this is the very reason that “unwanted ink [is] removed by mechanical means to leave the unimaged areas 28” during a previous step shown from FIGS. 5B to 5C of Hill. *Id.* at p. 40, lines 13-16. Thus, Hill teaches away from the office action’s proposed addition of pigment to the

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note, however, the present remarks show that neither the covercoat 36 nor undercoat 38 disclose or render obvious the recited “said another of said layers” in claim 1.

covercoat 36. See MPEP 2143.01(V) (“If proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”); MPEP 2145(X)(D)(2) (“It is improper to combine references where the references teach away from their combination.”) (citation omitted); MPEP 2141.03(VI) (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) (underlining in original).

For at least these reasons, Applicants respectfully request the withdrawal of this rejection.

#### Claim 11

Claim 11 recites, among other things, that “said another of said layers comprises an ink comprising a pigment and a binding matrix,” and is patentable over Hill for reasons similar to those discussed above with respect to claim 9.

For at least these reasons, Applicants respectfully request the withdrawal of this rejection.

#### Claim 13

Claim 13 recites, among other things, that “the heat treatment process burns off said matrix, leaving said pigment on said sheet of glass outside said print pattern,” and is patentable over Hill for reasons similar to those discussed above with respect to claim 9. Specifically, Hill teaches away from leaving pigment in Hill’s unimaged areas 28, as explained above.

For at least these reasons, Applicants respectfully request the withdrawal of this rejection.

#### New Claims

New dependent claim 25 further distinguishes one or more embodiments of the present invention from Hill by specifically reciting, among other things, that “a portion of said another of said layers remains within said print pattern after said (a) burning, (b) vaporizing, or (c) removing.” As explained above, the layers 36, 38 in Hill are vaporized, and therefore do not “remain[] within said print pattern after said (a) burning, (b) vaporizing, or (c) removing,” as recited in claim 25

New dependent claims 26 further distinguishes one or more embodiments of the present invention from Hill by specifically reciting, among other things, that “the portion of said another of said layers comprises ink that remains within said print pattern after said (a) burning, (b) vaporizing, or (c) removing.” In contrast, the alleged another of said layers in Hill is merely an undercoat 38 or overcoat 36, which does not “comprise[] ink,” much less “ink that remains

within said print pattern after said (a) burning, (b) vaporizing, or (c) removing,” as recited in claim 26.

New independent claim 28 further distinguishes one or more embodiments of the present invention from Hill by reciting, among other things, that “another of said layers is printed both within and outside said print pattern” and that “said glass frit melts and fuses with said sheet of glass and migrates into said another of said layers and binds said another of said layers to said one of said layers and to said sheet of glass within said print pattern but does not migrate into said another of said layers or bind said another of said layers to said sheet of glass outside said print pattern.” The method of Hill et al. does not disclose such a combination of recitations.

#### **Hill in view of Whitehead**

Claims 3, 14, and 15 were rejected under 35 U.S.C. § 103(a) as obvious over Hill (WO 00/46043) in view of Whitehead (U.S. Patent No. 4,321,778). 2/19/09 Office Action, ¶ 12. These claims depend, either directly or indirectly, from claim 1, which is patentable over Hill as explained above. Whitehead does not cure the above-discussed deficiencies of Hill with respect to claim 1. Accordingly, Applicants respectfully request the withdrawal of this obviousness rejection at least because these claims depend from nonobvious claim 1.

#### **Hill in view of Yamano**

Claims 7, 8, and 13 were rejected under 35 U.S.C. § 103(a) as obvious over Hill (WO 00/46043) in view of Yamano (U.S. Patent No. 4,971,858). 2/19/09 Office Action, ¶ 14. These claims depend, either directly or indirectly, from claim 1, which is patentable over Hill as explained above. Yamano does not cure the above-discussed deficiencies of Hill with respect to claim 1. Accordingly, Applicants respectfully request the withdrawal of this obviousness rejection at least because these claims depend from nonobvious claim 1.

#### **Conclusion**

To the extent that Applicants have not separately addressed each rejection of each dependent claim, this is not to be construed as an admission of the correctness of that rejection. Rather, Applicants believe that the independent claims are patentably distinguishable over the cited references for the reasons noted above, so that the rejection of one or more of the dependent claims need not be addressed at this time. Applicants reserve the right to address the rejection of any dependent claim at a later time should that become warranted.

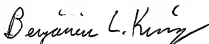
Applicants submit that the present application is in condition for allowance, and earnestly solicit an early notification to that effect.

Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

A handwritten signature in dark ink, appearing to read "Benjamin L. Kiersz", with a stylized flourish at the end.

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